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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO. *	CONFIRMATION NO.
10/814,390	03/30/2004	Peter E. Hand	359999.35	5402

7590 07/11/2007
David B. Abel
DLA Piper Rudnick Gray Cary US LLP
Fourth Floor
1999 Avenue of the Stars
Los Angeles, CA 90067

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

MAIL DATE	DELIVERY MODE
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07/11/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/814,390

Applicant(s)

HAND ET AL.

Examiner

Jeffrey A. Shapiro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/12/07 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "second value" in line 5 of Claim 9. There is insufficient antecedent basis for this limitation in the claim.

4. Claims 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's claims limitations require the "vending machine protocol program to accept notes only up to a first value...and a processor controlling the acceptance and

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recognition of notes up to a second value exceeding said first value". See, for example, Claim 19, lines 4, 5, 11 and 12.

It is not clear how the VMC, which controls the bill validator, can limit the acceptance of notes up to a first value, while still allowing the processor controlling the bill validator to accept bills up to a second value larger than the first value since the bill validator is being controlled by the VMC. For purpose of examination, it will be assumed that Applicant is referring to increasing the value of the largest denomination accepted by the machine by installation of a validator with new software that accepts the second, larger value.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al (US 6,363,164 B1) in view of Ramachandran et al (US 6,941,274 B1), and further in view of Partyka et al (US 5,941,363).

As described in Claim 8, Jones discloses an automated teller machine (ATM) as shown in figures 1b-d, that has a processor-based controller and coin receipt and return functions. Note that Jones' ATM vends bills and coins to customers. See Jones, figure 1a and col. 6, lines 22-46, which indicates that a customer's deposit may be returned in

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either coins, bills or both, and that controller (10) causes the dispensing unit (22) to dispense funds to a user. Figure 1e, for example, illustrates dispenser (22), communications panel (26), image scanner (12), input receptacle (16), transport mechanism (18), and output receptacles (20a and b), all controlled by processor-based controller (10). Controller (10) also directs information from scanner (12), discriminator (14) to interface (24) which communicates further with remote accounting systems. Jones also discloses a front-end processor (6038) in figures 1u and 1v. See col. 11, lines 35-64. Jones at col. 16, line 56-col. 17, line 30 discloses scanning a bill for various image features and comparing them with stored information. See also Jones at col. 20, line 26-col. 22, line 15, noting EPROM (934), illustrated in figure 4a, and CPU 930. See also Jones at col. 22, lines 30-56 and col. 26, lines 30-56. Jones at col. 27 line 56-col. 28 line 67 and col. 29 line 33-col. 30, line 26 describes microprocessor (212) storing obtained optical image and magnetic data from bills and comparing them with stored patterns stored for example in read only memory (232). Jones also discloses an escrow holding area in col. 77, lines 51-54.

As described in Claims 9-11, Jones further discloses a display (2402) in the form of a touch screen with various currency denominations the machine control will allow to be processed displayed as keys (2406a-g). Note that said display is supported in a bezel assembly. Note that disposing the display either on or adjoining the runway surface is considered to be obvious variations of each other that one ordinarily skilled in the art would have found obvious to use in Jones apparatus. Jones discloses a display (2304) in a bezel with denomination keys (2306a-g) located on a lower area of the bezel

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that can be construed as a runway area in figures (49a and b) and discussed in col. 65, line 52-col. 66, line 23. See also figure 50a or 57b as well as col. 66, lines 23-45, col. 72, line 60-col. 73, line 37, and col. 80, lines 49-59.

Jones does not expressly disclose, but Ramachandran discloses placing an ATM type device in a vending machine. See Ramachandran col. 2, line 45-col. 3, line 32 and col. 8, lines 23-42.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have embodied Jones' ATM in a combination ATM/vending machine for the purpose of dispensing snacks and goods as well as handles bank transactions.

The suggestion/motivation to do so would have been increase the range of services available to customers, thereby acting as a further draw to the vending machine, and therefore increasing profits, as suggested by Ramachandran's teaching and disclosure. See Ramachandran, col. 2, line 60-col. 3, line 10. Also, one ordinarily skilled in the art would have recognized the benefit of combining an ATM and vending machine because customers obtaining money at the ATM may be more willing to make impulsive purchases, thereby resulting in increased sales of vended goods as compared to a typical free-standing vending machine.

Further, regarding the use of a vending machine controller (VMC), Applicant's "Background to the Invention" section at paragraph 5, line 1-3 mentions that "vending machines are in wide use..." Paragraph 6 of the same section mentions that MDB/ICP communication protocol allows a bill validator to communicate with a vending machine controller (VMC). Since Ramachandran provides the teaching to retrofit an ATM bill

validator in a vending machine, it would therefore have been obvious for one ordinarily skilled in the art to have used such an MDB/ICP protocol to allow the various controllers and components of the vending system, including the bill and coin validators to communicate with the main controller.

Jones does not expressly disclose, but Partyka discloses that the note validator (14) controls a coin changer (12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have controlled Jones's coin changer by input from Jones' note validator, and the note validator in turn by the VMC.

The suggestion/motivation would have been to "provide payout of coin change in response to the receiving of a proper bill." See Partyka, col. 2, lines 45-52.

7. Claims 1-5, 7 and 12-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al in view of Ramachandran, further in view of Partyka and still further in view of Katou et al (US 2004/0182677 A1).

Jones and Ramachandran disclose the system described above.

Regarding Claims 12-17, see discussion regarding Claims 9-11 above.

Jones does not expressly disclose, but Katou discloses a vending machine in the form of automated teller machine (101), having a note acceptor-dispenser (1), a bill discriminator (30), a note box (60), a note hopper (40) that temporarily stores said notes, and a transportation unit (501, 502, 503, 504) in a combination such that said notes are transported to either a note box, a temporary storage or escrow box, or

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through the bill discriminator. See figures 6-13, 23-26, 30a-30c and 31. Also note the direction arrows of figures 6-13, 23-26, 30a-30c and 31.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added the transport mechanism disclosed and taught by Katou illustrated in Katou's figure 6, for example, to the transport mechanism of Jones such that said notes are transported to either a note box, a temporary storage or escrow box, or through the bill discriminator as well as from input to output receptacles.

The suggestion/motivation for adding Katou's transport mechanism to Jones' would have been to prevent jamming of notes. See Katou, paragraphs 10 and 18. Further, it would have been obvious to use closed note boxes or cassettes or magazines to receive notes rather than open receptacles as Jones discloses so as to promote automation of the note handling process.

Regarding Claims 19 and 20, which require the "vending machine protocol program to accept notes only up to a first value...and a processor controlling the acceptance and recognition of notes up to a second value exceeding said first value", note that it would have been obvious to upgrade a vending machine, which accepts coins or bills up to a one value, and increase the capability of the vending machine to accept bills of a higher value by installing a bill validator having a processor controller that allows bills of a second, higher maximum value, since prices of items can be expected to rise over time, thus requiring larger denominations to be transacted during a vend.

Response to Arguments

8. Applicant's arguments filed 12/12/07 have been fully considered but they are not persuasive.

Regarding Applicant's assertions concerning the lack of disclosure of a VMC in either Jones or Ramachandran, again, Applicant's "Background to the Invention" section at paragraph 5, line 1-3 mentions that "vending machines are in wide use..." Paragraph 6 of the same section mentions that MDB/ICP communication protocol allows a bill validator to communicate with a vending machine controller (VMC). Since Ramachandran provides the teaching to retrofit an ATM bill validator in a vending machine, it would therefore have been obvious for one ordinarily skilled in the art to have used such an MDB/ICP protocol to allow the various controllers and components of the vending system, including the bill and coin validators to communicate with the main controller.

Further, again, note that Partyka discloses that the note validator (14) controls a coin changer (12).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have controlled Jones' coin changer by input from Jones' note validator, and the note validator in turn by the VMC.

The suggestion/motivation would have been to "provide payout of coin change in response to the receiving of a proper bill." See Partyka, col. 2, lines 45-52.

Finally, Regarding Claims 19 and 20, which require the "vending machine protocol program to accept notes only up to a first value... and a processor controlling the acceptance and recognition of notes up to a second value exceeding said first

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value", note that it would have been obvious to upgrade a vending machine, which accepts coins or bills up to a one value, and increase the capability of the vending machine to accept bills of a higher value by installing a bill validator having a processor controller that allows bills of a second, higher maximum value, since prices of items can be expected to rise over time, thus requiring larger denominations to be transacted during a vend.

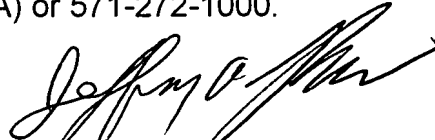
Since Applicant's Claims are considered to read on the prior art as described above, Claims 1-5 and 7-20 are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey A. Shapiro
Examiner
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June 25, 2007